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022249
LYON AND LYON LLP
SUITE 4700
633 WEST FIFTH STREET
LOS ANGELES CA 90071-2066

LMC1/1025

EXAMINER

TSANG, F

ART UNIT

PAPER NUMBER

2748

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.	09006274	Applicant(s)	Katy
Examiner	Tsang	Group Art Unit	2748

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE —3— MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- Responsive to communication(s) filed on _____.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- Claim(s) 29-41 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- Claim(s) _____ is/are allowed.
- Claim(s) 29-41 is/are rejected.
- Claim(s) _____ is/are objected to.
- Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The proposed drawing correction, filed on _____ is approved disapproved.
- The drawing(s) filed on _____ is/are objected to by the Examiner.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - All Some* None of the CERTIFIED copies of the priority documents have been received.
 - received in Application No. (Series Code/Serial Number) _____.
 - received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

- Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 & 3
- Interview Summary, PTO-413
- Notice of References Cited, PTO-892
- Notice of Informal Patent Application, PTO-152
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Other _____

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Part III DETAILED ACTION

Information Disclosure Statement

1. The Information Disclosure Statement submitted July 24, 1998 and Nov. 13, 1998 have been considered to the extent the examiner reasonably can at the present time. Examiner wants to state that applicant should fill in the class/subclass section for every reference cited in the IDS or cross the class/subclass section with a straight line in order to avoid future problem when the application is ready for issue. It is a great burden to the examiner to cross all the class/subclass sections on the submitted 45 pages of IDS.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 29-31, 34, 35 and 41 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Szlam et al. (Pat. No. 4,797,911) in view of either the SPEECH TECHNOLOGY article of

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Moosemiller ("Moosemiller") or the patent of Kraus (Pat. No. 3,920,908).

In view of the decision in the interference of the parent application 08473320, including the detailed analysis of the respective references therein, it should be clear that applicant's claim 29 is effectively met by the Szlam et al. patent, **except for** the identification of the "select operating format" based on the DNIS. As noted above, Szlam et al. is not found to have specifically taught or suggested that feature. However, that is a feature that was well known long before applicant's effective filing date(s), as evidenced by for example by Moosemiller, wherein see page 88, third column, first full paragraph; page 91, first column, "Development", first paragraph thereof; and page 92, first column, "Prototyping", **or** by Kraus, column 5, lines 30-42 (describes both ANI and DNIS-type features); and various operating "formats" (see column 7, lines 29-39). Inasmuch as all of the cited references describe what are more recently called "automated attendant" systems with certain aspects of interactions between callers and the subscriber's system "automated" to supplement or replace human operators, and either Moosemiller or Kraus showed that it was old and well known to use DNIS-type operation (that is, forwarding a

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caller telephone number to the system for processing to effect some control over how the system interacts with the caller) to select the operating "format" of the system, it clearly would have been *prima facie* obvious to one of ordinary skill in the art to apply the DNIS selection of format as taught by Moosemiller or Kraus in the system of Szlam et al.

4. Claims 32, 33, 36-39 and 40 are rejected under 35 U.S.C.

§ 103(a) as being unpatentable over the references as applied to claim 29 above, and further in view of Crane et al. (Patent No. 4,866,756). Although the examiner believes that one of ordinary skill in the art would have recognized from the references applied to claim 29 alone, together with his or her own extensive knowledge of this very crowded art, that well known security and access control techniques could desirably be used in any system involving automatic or semiautomatic interactions between callers and controlled accounts stored in the memories of the system, owners which the callers were calling, for the record the examiner cites as one of many available examples, the patent of Crane et al., wherein see column 10, lines 41-61. This is another automated attendant system that obviously must control how and to what extent callers may interact with the system and records thereon. Therefore, in Crane et al. there clearly is

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"qualification structure", "PIN" numbers, and a variety of specified limits on use and access, all of which clearly would have been applicable in the Szlam et al., Kraus and Moosemiller systems. In this context, note also in the Kraus patent, the credit verification aspects as described at column 6, lines 32-56; column 7, lines 29-39; and column 10, lines 40-44.

Therefore, to the extent the rejected claims are supported, they are found to be clearly within the scope of the prior art.

5. It is noted that claims 29-41 were presented and then canceled in the prior application. However, examiner fails to access the file of the parent application when he is examining this application. Examiner reviews some notes and rejections left from Examiner Brown who handled the parent case. Examiner believes the pending claims 29-41 are rejected for the above reasons.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional

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rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 29-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 5815551.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims in the continuation are broader than the ones in patent, *In re Van Ornum and Stang*, 214 USPQ 761, broad claims in continuation application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 29 of the present invention is the same as claim 1 of the patent except that the plural call distributors was not recited in claim 29. Therefore, claim 29 of the present invention is broader than claim 1 of the patent.

8. Claims 29-41 are rejected under the judicially created doctrine of double patenting over claims 1-13 of U. S. Patent No. 5815551 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject

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matter, as follows: a system to be utilized with a telephone facility for on-line handling of customer data contained in a memory in accordance with a selected operating format.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Conclusion

9. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 308-5403 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Tsang whose telephone number is (703) 305-4895. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Krista Zele, can be reached on (703) 305-4701. The fax phone number for this Group is (703) 308-5403.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [krista.zele@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195

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OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Fan Tsang
Primary Examiner
Group 2748
October 25, 1999

FAN S. TSANG
PRIMARY EXAMINER

